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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,770	11/27/2000	Jac-Hong Park	A33777	4853

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EXAMINER
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MOORE JR, MICHAEL J

ART UNIT	PAPER NUMBER
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2666

DATE MAILED: 03/25/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/722,770

Applicant(s)

PARK ET AL.

Examiner

Michael J Moore, Jr.

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 10, 13, 15, 19, 20, 34, 39, 43, 45, 50 and 54-56 is/are rejected.
- 7) ☒ Claim(s) 5-9, 11, 12, 14, 16-18, 21-33, 35-38, 40-42, 44, 46-49 and 51-53 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3.8</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) received on 2/27/2001 and 8/13/2002 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The disclosure is objected to because of the following informalities: On page 8, line 19; the term "PLMD" should be "PLMN". On page 9, lines 17 and 18; the terms "HPLMN" and "VPLMN" should be defined as "home public land mobile network" and "visited public land mobile network", respectively. On page 12, line 20; there is some confusion regarding the phrase "which is higher than "0" and the maximum". Appropriate correction is required.

### ***Claim Objections***

4. Claims 1, 2, 5, and 7 are objected to because of the following informalities:  
Regarding claim 1, on line 16 there is a missing "a" between "of" and "core".  
Regarding claim 2, on line 5 there is a missing "a" between "of" and "core".  
Regarding claim 7, on line 3 there appears to be a "find" missing between the words "to" and "the". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims **1, 4, 10, 13, 15, 19, 20, 34, 39, 43, 45, 50, and 54-56** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim **1**, there is some confusion regarding the phrase “performing a location registration of the found cell” in step e. It is believed that the “mobile station” is what is actually registered, and not the “cell”.

Regarding claim **4**, there is some confusion regarding the English used in step b2. The language of this step in the claim should be written more clearly. Also, claim **4** recites the limitation “the asynchronous core network or the synchronous core network” in lines 8 and 9. There is insufficient antecedent basis for this limitation in the claim.

Claim **10** recites the limitation “the information about the other cells” in line 7. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim **13**, there is some confusion regarding the phrase “performing the location registration of the selected cell” in step e34. It is believed that the “mobile station” is what is actually registered, and not the “cell”.

Claim **15** recites the limitation “the step e83)” in line 7. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim **19**, the step number “d21” is already used in claim **8**, which causes some confusion.

Claim 20 recites the limitation "the information about the other cells" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 34 recites the limitation "the other cells except for some cells among the neighboring cells" in lines 7 and 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 39 recites the limitation "the step e43)" in line 11. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 43, there is a numbering problem with this claim. There should be a "period" following "43" instead of a "comma" in order to be a properly numbered claim.

Claim 45 recites the limitation "the other cells except for some cells among the neighboring cells" in lines 7 and 8. There is insufficient antecedent basis for this limitation in the claim.

Claim 50 recites the limitation "the step e83)" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 54, there is some confusion as to the phrase "one of both core networks" in line 5. Also, claim 54 recites the limitation "the asynchronous core network and the synchronous core network" in lines 4 and 5. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 55, there is some confusion as to the idea of storing a selection algorithm in a user.

Claim 56 recites the limitations "the step b3)" in line 6 and "the step b4)" in line 8.

There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1-3 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. (U.S. 6,463,055) in view of Nordstrand (U.S. 6,334,052).

Regarding claim 1, Lupien et al. discloses a General Packet Radio Service (GPRS) packet data network (asynchronous radio network) that contains a serving GPRS switching node (SGSN) that provides packet switching services to a mobile station in Figure 2. This asynchronous radio network is interlocked with an ANSI-41 circuit switched network (core network) in Figure 2. Lupien et al. also discloses a

power-up attach procedure where a mobile station will attach to a circuit switched service, a packet switched service, or both services depending upon the class of the mobile station (core network discriminator) in column 9, lines 33-43. Lupien et al. also discloses a GPRS attach procedure (GSM cell procedure) and an MIN attach procedure (ANSI cell procedure) performed by a mobile end station in Figure 6 and in column 23, lines 24-40. Figure 6 shows an attach procedure where a service is established through a location update 71 and registration steps 78 and 88.

Lupien et al. does not disclose the storing of information related to the core network in a memory or a User Subscriber Identity Module (USIM) before power-off of the asynchronous mobile station. However, Nordstrand discloses a mobile station that contains a Subscriber Information Module (SIM) 205 in Figure 2 that contains PLMN access information. At the time of the invention, it would have been obvious to someone of ordinary skill in the art given these references to combine the cell selection method of Lupien et al. with the mobile station of Nordstrand. A motivation would be to have a means for determining whether a mobile communications device is permitted to camp on one of the cells in a PLMN as stated in column 4, lines 29-43. This motivation applies to the following rejections of claims **2, 3, and 54**.

Regarding claim **2**, Lupien et al. further discloses in column 14, lines 47-56 that when a GPRS network is involved, the class of the mobile station (core network discriminator) and an International Mobile Station Identification (IMSI) (PLMN ID that contains an MCC and an MNC) are stored in a SIM card as described in the GPRS standards.

Regarding claim 3, Lupien et al. further discloses in column 3, lines 56-61 that when an ANSI-41 network is involved, the class of the mobile station (core network discriminator) and a Mobile Identification Number (MIN) (contains a SID and an NID) are used by the mobile station.

Regarding claim 54, Lupien et al. further discloses in column 23, lines 28-36 that based upon the class of mobile station (core network discriminator), the mobile station will either perform a GPRS attach (asynchronous) or a MIN attach (synchronous) as defined in ANSI-41 standards.

***Allowable Subject Matter***

10. Claims 5-9, 11, 12, 14, 16-18, 21-33, 35-38, 40-42, 44, 46-49, and 51-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action as well as being rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nizri et al. (US 2002/0197992), Seazholtz et al. (U.S. 6,128,489), Wallstedt et al. (U.S. 6,542,741), and Blakeney, II et al. (U.S. 6,085,085) are all references that contain material pertinent to this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Moore, Jr. whose telephone number is (703)



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305-8703. The examiner can normally be reached during the hours of 8:30am - 5:00pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached at (703) 308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael J Moore, Jr.  
Examiner  
Art Unit 2666

mjm MM

*Seema S. Rao*  
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